

REMARKS/ARGUMENTS

The office action of February 16, 2006 (Office Action) has been considered and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-37 are pending in this application.

Informal examiner interview

Applicants thank Examiner Bonshock for the courtesies extended to the undersigned during the informal examiner teleconferences of March 4, 2006 and March 13, 2006. During the interviews, we discussed operation of the Drempels screensaver, which has two different modes (i.e., a screensaver mode and a background display mode) that operate independently, are executed independently, and have independent functionality. Examiner Bonshock requested that we formally present our arguments in an after-final amendment.

35 U.S.C. §103 rejections to claims 1-13, 24-28, 31 and 33-37

Claims 1, 3-8, 11-13, 24-27, 29-31 and 35-37 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Serandom and the cited reference entitled “Drempels” (Drempels). Claims 2, 9, 10, 14-23, 28, 33 and 34 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Serandom and Drempels and further in view of U.S. patent no. 6,507,351 to Bixler (Bixler). Applicants respectfully traverse these rejections.

Factual errors regarding the prior art - Drempels

The Office Action makes clear factual errors regarding its analysis of Drempels. In particular, the Office Action interprets drempels.scr as being an application that is fully functional in a full application mode and drempels.scr when “run by a manager program and not its own executable (‘drempls.exe/s’)” as being less than fully functional in the screen saver mode, because “any attempt at a function (such as those on page 7) while running will terminate the screensaver, leaving ‘drempls.scr’ with less than full functionality.” Office Action, page 20, lines 4-7. This is a completely erroneous interpretation of Drempels.

In contrast, Drempels specifically teaches that attempting various functions, like those on page 7, causes the screen saver *to perform the functions* rather than to terminate as asserted by the Office Action. Further, Drempels teaches that, while in the screen saver mode, it performs functions *that cannot be performed* while in the desktop mode.

For instance, Drempels specifically states, “In Fullscreen [Screensaver] Mode, Drempels behaves like a normal screensaver: it takes over the entire screen, and you can move the mouse, or hit ESCAPE to exit. *You can also use many of the Drempels’ hotkeys – press ‘h’ for a list.*” Drempels, page 6, lines 4-6. The list of hotkeys referred to by Drempels as listing functions for the screensaver mode is the list of functions on page 7 of Drempels that was erroneously referred to by the Office Action as functions that would terminate the screensaver. The assertion of the Office Action is clear error. As another example of functions that would not terminate the screen saver mode, on page 7, Drempels notes that an operator can “hit ‘N’ to minimize the window (*fullscreen [screen saver] mode only*).”

Drempels clearly teaches that it can perform functions while in the screen saver mode that would not terminate the screen saver, which includes one or more functions that cannot be performed while in the desktop mode. Further, Drempels specifically teaches that the screen saver is terminated by moving the mouse or hitting the ESCAPE key, rather than by attempting any function as asserted in the Office Action. *Id.* at page 6, lines 4-6.

During the teleconferences, the examiner indicated that the Drempels’ program would operate differently when executed via “drempels.scr” versus being executed by the Windows screen saver manager via “drempels.exe /s.” Such a position is clearly erroneous. Drempels states, “To run the screensaver: “drempels.exe /s” (always uses fullscreen mode).” Drempels, page 8, line 11. After disclosing the .exe options for executing the drempels program, Drempels explicitly notes, “NOTE: you *can also* run it as a screensaver by using drempels.scr (located in your windows SYSTEM directory) in the normal fashion.” Emphasis added. *Id.* at lines 17-18. Thus, Drempels plainly teaches that its program can be executed in the screen saver mode in one or two ways - either via “drempels.exe /s” or “drempels.scr.” Regardless of how it is executed as a screen saver, Drempels unmistakably teaches that it has functionality via its hotkeys (e.g., “N” to minimize), which does not cause it to terminate.

During the teleconferences, the examiner indicated that the windows screen saver could execute Drempels.exe for the screen saver mode, which would be terminated when a user attempts any function. This assertion is also completely contrary to the teachings of Drempels. Drempels explicitly states, "Drempels will run in either fullscreen or desktop mode based on how you launch it." Drempels, page 8, lines 9-10. In addition, Drempels unmistakably teaches,

Drempels will now run in either fullscreen or desktop mode, based on *how you launch it*. The screensaver *always* runs in fullscreen mode, while the 'application' version *always* runs in desktop mode.

(The "application" version is invoked by clicking a shortcut to Drempels, *as opposed to* running it as a Windows screensaver.)

Emphasis added.

The Office Action clearly misinterprets Drempels contrary to its explicit teachings. Drempels unmistakably teaches that it can perform functions while in the screensaver mode (e.g., 'N' to minimize) based on hotkeys, which would not terminate the screensaver. Further, Drempels plainly teaches the use of the mouse or the ESCAPE key to terminate the screensaver rather than any attempt at a function doing so as asserted in the Office Action. The assertion in the Office Action is completely contrary to Drempels' teachings of performing functions while in the screen saver mode in response to entry of a hotkey. Further, such an assertion would render useless the disclosed screen saver hot key functionality of Drempels.

Lack of a prima facie basis

To establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case, Applicants respectfully submit that the Office Action fails to make a *prima facie* basis for rejecting the pending claims, at least in view of its factual errors with respect to Drempels and because the cited references, either alone or in combination, fail to teach or suggest all claim features.

Drempels fails to disclose the recited subject matter of these claims pertaining to an application that is fully functional in a full application mode and that is less than fully functional in a screen saver mode. Instead, Drempels teaches an application that has two modes - a screensaver mode and a desktop (background) mode, of which neither are fully functional. The

Drempels' modes have common functionalities, as well as exclusive functionalities for each mode. However, neither mode of Drempels is fully functional.

While the Drempels application is in the fullscreen (screensaver) mode, the user can interact with it via hotkeys. The hotkeys include the hotkey "N" "to minimize the window (fullscreen mode only)."
Emphasis added. Drempels text file, page 7. The display in this mode fills the screen to form a fullscreen screensaver display. While the Drempels program is in its screensaver mode, "you can also use many of the Drempels hotkeys," (*Id.*) without selecting the DR icon required for the desktop mode. Clearly, the Drempels application has certain functionalities while in the screensaver mode that are not included in the desktop mode (e.g., the 'minimize' hotkey, full screen display functionality, and full-time hot key functionality) and vice-versa.

While the Drempels application is in the desktop mode, it is responsive to the hotkey controls "only when the 'DR' icon in the system tray is highlighted in green." *Id.* at page 6. Otherwise, keystrokes are routed to other active applications. Further, in this mode the Drempels application displays images in the background portion of the screen. Hence, the Drempels program is not fully functional in the desktop mode and may even be less functional in its desktop mode than in its screensaver mode, as it can only receive hotkey commands when the user explicitly selects the 'DR' icon, it is not capable of being minimized, and its display does not fill the screen.

In contrast, independent claim 1 recites, among other features, the subject matter of
executing the application in the screen saver mode based on instructions from the screen saver program, the application being a program independent from the screen saver program that is fully functional in a full application mode and that is less than fully functional in a screen saver mode, the application creating an image for presentation on a display screen in the screen saver mode.

Similarly, independent claim 24 recites, among other features, the subject matter of

an application stored in the storage medium that is fully functional in a full application mode and less than fully functional in a screen saver mode, the application being a program that is independent from the screen saver program, the method comprising the steps of:

...

selecting the application handle via the screen saver program to execute the application in the screen saver mode.

Likewise, independent claim 29, from which claims 31 and 33 depend, recites, among other features, the subject matter of

A computer readable medium having computer-executable instructions for performing steps comprising:

...

evaluating whether a screen saver carousel contains application handles, each of the application handles executing a respective application in a screen saver mode when selected by the screen saver program, the application being an independent program from the screen saver program and being a program that is fully functional in a full application mode and that is less than fully functional in a screen saver mode; and

if the carousel contains at least one application handle, and if the timeout period has been exceeded, selecting the at least one application handle to execute the respective application.

In addition, independent claim 34, recites, among other features, the subject matter of
A portable device comprising:

...

a computer application stored in the memory, the application having at least one handle executing the application in a screen saver mode when the at least one handle is selected, the application being a program that is fully functional in a full application mode and is less than fully functional in a screen saver mode, the application creating images for presentation on the display screen in the screen saver mode

Drempels simply fails to disclose the recited subject matter of these claims pertaining to an application that is fully functional in a full application mode and that is less than fully functional in a screen saver mode. Neither Serandom nor Bixler overcome these deficiencies of Drempels, nor were they relied upon such teachings. For at least these reasons, Applicants respectfully submit that independent claims 1, 14, 24, 29 and 34, as well as claims 2-13, 15-23, 25-28, 31-33 and 35-37 depending therefrom, are allowable over the prior art of record.

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Conclusion

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact applicant's undersigned representative at the below-listed number.

Respectfully submitted,
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Dated: May 16, 2006

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